

REMARKS

This application has been carefully reviewed in light of the Office Action dated August 6, 2003 (Paper No. 2). Claims 1 to 22 are in the application, with Claims 15 to 22 having been added herein. Claims 1, 7, 13, 14, 17 and 20 are the independent claims. Reconsideration and further examination are respectfully requested.

Claim 14 was rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,749,024 (Young); Claims 1, 4, 7 and 13 were rejected under § 103(a) over U.S. Patent No. 5,177,543 (Rodenberg) in view of U.S. Patent No. 5,869,824 (Okada) and further in view of U.S. Patent No. U.S. Patent No. 5,709,374 (Taylor); Claims 2, 3, 5 and 11 were rejected under § 103(a) over Rodenberg in view of Okada and Taylor and further in view of U.S. Patent No. 5,282,050 (Ishizuka); and Claims 6 and 12 were rejected under § 103(a) over Rodenberg in view of Okada and Taylor and further in view of U.S. Patent No. 6,377,356 (Sakamoto).

Initially, Applicants note that while the Office Action Summary indicates that Claims 8 to 10 were rejected, the Office Action does not appear to include these claims in any of the specific rejections. Since the subject matter of Claims 8 to 10 corresponds with that of Claims 2 to 4, respectively, Applicants have relied on the Examiner's comments concerning Claims 2 to 4 in preparing this amendment. Should the Examiner continue to reject Claims 8 to 10, Applicants request that the rejection of these claims be included in any subsequent Office Action.

Applicants also note that in the rejection of Claim 13, the Office Action associates the patent number for the Hicks reference listed on page 7 of the Office Action

with Rodenberg. Based on the Examiner's comments, Applicants have assumed that the Office Action is referring to Rodenberg and have prepared this amendment accordingly. Should the Examiner choose to maintain the rejection, however, clarification is respectfully requested.

With the foregoing assumptions, Applicants have considered the Examiner's comments together with the applied references and respectfully submit that the claims herein are patentably distinguishable over the applied references for at least the following reasons.

Independent Claims 1, 7 and 13 concern controlling a printing device to output predetermined data onto a printing medium. According to one aspect of the invention, a separation printing setting and a printing order setting are checked. The separation printing setting is set in advance and represents whether a predetermined medium is additionally output over each page of the output predetermined data. The printing order setting is also set in advance and can be set with respect to individual print jobs. The printing order setting represents whether the predetermined data is output from a final page or from a first page. When the separating printing setting is set to additionally output the predetermined medium and the printing order setting is set to output the predetermined data from the first page, the printing device is controlled to output each page of the output predetermined data and then additionally output the predetermined medium before a next page is output. When the separation printing setting is set to additionally output the predetermined medium and the printing order setting is set to output the

predetermined data from the final page, the printing device is controlled to output the predetermined medium before each page of the output predetermined data is output.

The applied references are not understood to disclose or suggest the foregoing features of the present invention. In particular, the applied references are not understood to disclose or suggest at least the features of checking a printing order setting representing whether predetermined data is output from a final page or from a first page and controlling whether a predetermined medium is output before or after each page of the predetermined data based on the printing order setting.

Rodenberg concerns an electrostatographic printer which can interleave plain paper between transparencies formed using the printer. However, as conceded in the Office Action, Rodenberg is not understood to disclose or suggest changing the order in which the plain paper is interleaved based on the printing order of the transparencies.

Okada and Taylor were cited in combination with Rodenberg for their respective descriptions concerning banner pages. Specifically, Okada concerns a data output controller which determines if a banner page has been added to a print job when print data is received and Taylor teaches a system in which a banner sheet is automatically printed before or after the first or last sheets of a print job.

Initially, Applicants submit that one of ordinary skill in the art would not have been motivated to look to Okada and Taylor in combination with Rodenberg to solve the problem of transparencies sticking together, as contended in the Office Action. It is unclear why one skilled in the art would look to references which involve the processing and handling of banner pages when trying to prevent transparencies from sticking together. Furthermore, Rodenberg discloses a solution to this problem in column 3, lines 62 to 66,

which describes interleaving plain paper between adjacent transparencies, and therefore Rodenberg provides no motivation to look at other references to solve this problem.

Even if there were proper motivation to combine these references, the combination of Rodenberg, Okada and Taylor is not seen to disclose or suggest the claimed features of the invention. Specifically, the banner pages discussed in Okada and Taylor are not understood to be placed between the pages of a print job. Rather, these banner pages are output either before or after the print job has been output. Therefore, Okada and Taylor, either alone or in combination with Rodenberg, are not understood to disclose or suggest at least the features of checking a printing order setting representing whether predetermined data is output from a final page or from a first page and controlling whether a predetermined medium is output before or after each page of the predetermined data based on the printing order setting.

Young, which was applied in the rejection of independent Claim 14, is not understood to disclose or suggest anything to remedy the foregoing deficiencies of Rodenberg, Okada and Taylor. Young concerns a printing system which changes the output order of printed transparency sheets and their corresponding paper sheets depending on the type of connected output unit. However, this change in the output order described in Young is not understood to be performed based on a checked printing order setting. Rather, Young is understood to make this change based on an output unit that is physically connected to the system. Therefore, Young is not understood to disclose or suggest at least the features of checking a printing order setting representing whether predetermined data is output from a final page or from a first page and controlling whether a predetermined

medium is output before or after each page of the predetermined data based on the printing order setting.

Ishizuka and Sakamoto, which were applied in the rejections of certain dependent claims, are not seen to disclose or suggest anything to remedy the foregoing deficiencies. Specifically, neither Ishizuka nor Sakamoto are understood to disclose or suggest at least the features of checking a printing order setting representing whether predetermined data is output from a final page or from a first page and controlling whether a predetermined medium is output before or after each page of the predetermined data based on the printing order setting.

Accordingly, independent Claims 1, 7 and 13 are believed to be allowable over the applied references. Reconsideration and withdrawal of the § 103(a) rejection of Claims 1, 7 and 13 are respectfully requested.

Independent Claim 14 concerns a printing control method in which printing settings are checked, where the printing settings can be set with respect to individual print jobs and include whether a plurality of different media are to be output for each page of data and which one of face-up printing and face-down printing is to be performed. An output order of the plurality of different media is determined based on which one of face-up and face-down printing is to be performed.

The applied references are not seen to disclose or suggest the foregoing features of the present invention. In particular, the applied references are not seen to disclose or suggest at least the feature determining an output order of a plurality of different media, which are output for each page of data, based on a printing setting indicating whether face-up printing or face-down printing is to be performed.

As described above with respect to independent Claims 1, 7 and 13, none of the applied references, either alone or in combination, are seen to disclose or suggest controlling the output order of a predetermined medium and each page of predetermined data based on a printing order setting. In light of this, Applicants submit that the applied references also are not understood to disclose or suggest determining an output order of a plurality of different media for each page of data based on a printing setting, where the printing setting indicates whether face-up printing or face-down printing is to be performed.

Accordingly, independent Claim 14 is believed to be allowable over the applied references. Reconsideration and withdrawal of the § 102(b) rejection of Claim 14 are respectfully requested.

New independent Claims 17 and 20 are apparatus and computer program claims corresponding to independent Claim 14. Therefore, independent Claims 17 and 20 are believed to be allowable over the applied references for at least the same reasons discussed above with respect to Claim 14.

The other claims in the application are dependent from the independent claims discussed above and therefore are believed to be allowable over the applied references for at least the same reasons. Because each dependent claim is deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merits is respectfully requested.

In view of the foregoing amendment and remarks, the entire application is believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

Turning to a formal matter, page 7 of the Office Action contains a list of references that have been indicated as being made of record in the application. However, the form PTO-892 attached to the Office Action does not include these references thereon. Accordingly, Applicants respectfully request a form PTO-892 listing the references identified on page 7 of the Office Action.

Applicants' undersigned attorney may be reached in our Costa Mesa, California, office by telephone at (714) 540-8700. All correspondence should be directed to our address given below.

Respectfully submitted,



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